UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,621	12/03/2004	Tatsuo Tsuneka	SAE-036	5295

20374 7590 11/08/2006

KUBOVCIK & KUBOVCIK
SUITE 710
900 17TH STREET NW
WASHINGTON, DC 20006

EXAMINER	
CHEUNG, WILLIAM K	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/516,621	TSUNEKA ET AL.	
	Examiner	Art Unit	
	William K. Cheung	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In view of amendment after Final filed October 25, 2006, claims 1-5 have been cancelled. Claims 6-11 are pending.

2. In view of the cancellation of claims 1-5, the rejection of claims 1-5 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ashihara et al. (US Patent 6,277,912), is withdrawn.

3. In view of applicants' argument filed October 25, 2006, the rejection of Claims 6-11 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ashihara et al. (US Patent 6,277,912), is withdrawn.

4. The examiner acknowledges that a mistake on the heading of paragraph 5 of the office action of December 21, 2006, because the heading of paragraph 5 does not reflect the content for the 103 rejection set forth in paragraph 5 of the office action. However, because the rejection of Claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Ashihara et al. (US Patent 6,277,912) in view of Verardi et al. (US Patent 5,863,646), issued in the office action of August 9, 2005, has never been withdrawn, Claims 6-11, rejected under 35 U.S.C. 103(a) as obvious over Ashihara et

al. (US Patent 6,277,912) in view of Verardi et al. (US Patent 5,863,646) remain rejected.

To avoid future communication problems, applicants are advised to argue each ground of rejection in separate paragraphs in the order of how claims were rejected. Applicants must recognize that arguing the rejections of claims that are under different grounds for rejection in random order can be confusing, and cause extra burden on the examiner when the application is being reviewed.

Regarding applicants' argument filed October 25, 2006 that a non-final office action should be issued, the examiner disagrees because the rejection of Claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Ashihara et al. (US Patent 6,277,912) in view of Verardi et al. (US Patent 5,863,646), issued in the office action of August 9, 2005, has never been withdrawn. Therefore, there is no new ground for rejection set forth.

In view of the reasons set forth above, the examiner is issuing the instant office action with a Final status.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 6-11 are rejected under 35 U.S.C. 103(a) as obvious over Ashihara et al. (US Patent 6,277,912) in view of Verardi et al. (US Patent 5,863,646) for the reasons adequately set forth from paragraph 5 of the office action of July 25, 2006, and/or paragraph 5 of the office action of August 9, 2005.

Applicant's arguments filed October 25, 2006 have been fully considered but they are not persuasive. Regarding applicants' argument that Verardi et al. do not disclose an equivalence of aromatic solvents and ethereal solvents in a process for preparing an aqueous-based composition as disclosed in Ashihara et al., applicants fail to recognize

that Verardi et al. (col. 6, line 42-44, 50-55) clearly disclose that the disclosed composition "may contain suitable solvents. Examples include aromatic solvents such as toluene, xylene, and naptha; ... Additional solvents include glycol ethers, and glycol ether esters such as ethylene glycol monobutyl ether,..... dipropylene glycol monoethyl ether.." Because Verardi et al. (col. 6, line 42-44, 50-55) clearly teach the suitability of aromatic solvents and ethereal solvents are suitable as solvents for the disclosed composition, Verardi et al. clearly support their functional equivalence as solvents. Therefore, applicants' argument is not persuasive.

Regarding applicants' argument that because the examiner fail to identify that Veradi et al. in the 103 rejection, the examiner can not rely on Verardi et al. as a reference, the examiner disagrees because the rejection of Claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Ashihara et al. (US Patent 6,277,912) in view of Verardi et al. (US Patent 5,863,646) issued on August 9, has not been withdrawn, and applicants have the opportunity to address the 103 rejection set forth.

Regarding applicants' argument that the reference, Ashihara et al., is not the closest prior art because it does not use an ethereal solvent, the examiner disagrees. Because the 103 rejection set forth relies on Ashihara et al., Ashihara et al. is the closest prior art on record. To obtain a valid patent, instead of arguing that the reference to Ashihara et al. is not the closest prior art, applicants should submit comparative data

to show that it is not possible to obtain a dispersion from the teachings of Ashihara et al. in the absence of ethereal solvent.

Conclusion

7. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William K. Cheung, Ph. D.

Primary Examiner

WILLIAM K. CHEUNG
PRIMARY EXAMINER

November 3, 2006